

REMARKS

Claims 2-32 and 35-36 remain pending in this application.

The Examiner rejected claims 2, 3, 5, 6, 11-14, 16, 17, 21-25, 28, 29, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,378 (*Wu*). Applicant respectfully traverses this rejection.

Claim 2 is directed to a method that calls for establishing a communication channel between a first transceiver and a second transceiver in low power mode; determining, at the first transceiver, a training parameter in response to establishing the communication channel in the low power mode; performing training, at the first transceiver, based at least on the training parameter; and providing the training parameter to the second transceiver.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Federal Circuit has emphasized that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

In the instant case, the Examiner has not met even a single criteria necessary to establish a *prima facie* case of obviousness. As an initial matter, the Examiner fails to point to any suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Rather, the Examiner uses the language of the claims as a template to argue that the teachings of the references are combinable. As noted, the mere fact that the prior art can be combined or modified does not make the resultant combination obvious. The Examiner has also failed to cite to a reasonable expectation of success. Finally, even if the cited references were properly combinable in the manner argued by the Examiner (and they are not), the pending claims are still allowable because these references, when considered alone or in combination, do not teach all of the claim limitations, as explained below.

In the Office Action, the Examiner argues that the claimed feature of determining a training parameter is disclosed by block 70C of Figure 9 of *Wu*. Block 70C of *Wu* refers to receiving a power spectrum density (PSD) REVERB signal from the remote unit 10 and, based on the PSD REVERB signal, calculates a PSD that the office modem 20 uses for downstream transmission with the remote unit 10. See col. 12, lines 21-26; lines 52-55. Because the Examiner asserts that block 70C of *Wu* teaches the claimed feature of “determining a training parameter,” the Examiner thus argues that the calculated “PSD” at block 70C corresponds to the “training parameter” that is determined in claim 2.

Claim 2 further specifies performing, at the first transceiver, training based at least on the training parameter. The Examiner argues that this claimed feature is shown in block 72C (Figure 9) of *Wu*. Contrary to Examiner’s assertion, *Wu* does not teach performing training, at the first transceiver, based on at least the training parameter (which the Examiner asserts is the PSD calculated at block 70C). Instead, *Wu* explains that, at block 72C, the central office modem 20 generates a TEQ training signal based on the calculated PSD (at block 70C). See col. 12, lines 62-67. Thus, *Wu* does not describe that central office modem 20 trains based on the calculated PSD, but rather that a TEQ training signal is generated and transmitted to the remote modem 10. As explained at col. 13, lines 1-46 of *Wu*, the remote modem 10, and not modem 20, uses the “TEQ training signal” for the purposes of training. Accordingly, contrary to the Examiner’s assertion, block 72C does not teach the claimed feature of performing training, at the first transceiver, based at least on the training parameter.

Claim 2 further calls for providing the training parameter to the second transceiver. As noted, according to the Examiner, the “training parameter” that is calculated at block 70C is the “PSD.” The Examiner asserts that this PSD value is provided to the remote unit 10 at block 72C

of Figure 9 of *Wu*. Contrary to the Examiner's assertion, the PSD value is not provided to the second transceiver (e.g., the remote modem 10). To the contrary, *Wu* describes that the PSD value calculated by the central service modem 20 at block 70C is the value that the modem 20 itself uses for downstream transmission with the remote modem 10. *See* col. 12, lines 21-26; lines 52-55.

Claim 2 and its dependent claims are thus allowable for at least the reasons presented above. Additionally, the other pending claims, to the extent they call for one or more of the above-noted missing features, are also allowable for these reasons.

Reconsideration of the present application is respectfully requested. In light of the arguments presented above, Applicant respectfully asserts that all claims are allowable. Accordingly, a Notice of Allowance is respectfully solicited.

Applicant acknowledges that the Examiner objected to claims 7-10, 18-20, and 26-27 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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